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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,417	09/10/2003	Chishio Hosokawa	OHTN: 006B	3198
6160	7590	02/22/2005	EXAMINER	
PARKHURST & WENDEL, L.L.P. 1421 PRINCE STREET SUITE 210 ALEXANDRIA, VA 22314-2805			DAVIS, BRIAN J	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/658,417

Applicant(s)

HOSOKAWA ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,5,10 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,5,10,14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/945,633.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***112 Rejections Withdrawn***

The rejection of claims 3-5, 8, 10, 12 and 13 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. With respect to claims 3, 8, 12 and 13, the amendment cancels the claims. With respect to the remaining claims, the rejection is moot.

### ***Claim Rejections - 35 USC § 112, NEW***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, the phrase "...*at least two* [emphasis added] of Ar<sup>5</sup> and Ar<sup>8</sup> each represent..." is unclear. In formula (2) of claim 14, there is only one instance each of Ar<sup>5</sup> and Ar<sup>8</sup>. Thus, in order to remove any possible ambiguity, the examiner respectfully suggests a slight rewording of the claim, something along the lines of: "...*both* [emphasis added] Ar<sup>5</sup> and Ar<sup>8</sup> each represent...". The analysis for claim 5 is similar.

***102 Rejections Withdrawn***

The rejection of claims 3-5, 8, 10, 12 and 13, in so far as they read on the species defined in the previous Office Action, under 35 USC 102(b) is withdrawn. Claims 3, 8, 12 and 13 have been canceled. With regard to the remaining claims (and in light of newly added claims 14-16), applicant is correct, the species is not encompassed by the instant claims.

***Allowable Subject Matter***

The elected species remains free of the prior art. The search therefore expanded as called for under current Office Markush practice, a compound-by-compound search, to include a single additional species. That species is defined when in formula (2): A = a five-membered ring structure including a spiro atom; B = vacant; Ar<sup>5-8</sup> = phenyl. A rejection follows:

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4, 5, 10 and 14-16, in so far as they read on the species defined above, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by DE 19711713 (and CAPLUS abstract). The reference teaches applicant's compound: RN=189363-47-1.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
February 15, 2005